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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,001	12/10/2001	Ynjiun P. Wang	T075A	3855
23623	7590	12/29/2005	EXAMINER	
AMIN & TUROCY, LLP 1900 EAST 9TH STREET, NATIONAL CITY CENTER 24TH FLOOR, CLEVELAND, OH 44114			JEANTY, ROMAIN	
			ART UNIT	PAPER NUMBER
			3623	

DATE MAILED: 12/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/016,001

Applicant(s)

WANG ET AL.

Examiner

Romain Jeanty

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, and 16-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 16-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 24-25 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage International Bureau (PCT Rule 17.2(a)).
- Office action for a list of the certified copies not received.

ing Review (PTO-948)  
PTO-1449 or PTO/SB/08)

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This Final Office Action is in response to the communication received September 6, 2005. Claims 1-4, and 16-25 are pending in the application for further examination.

### **Response to Arguments**

2. Applicant's arguments filed on September 5, 2005 have been fully considered but they are not persuasive.

### **Election/Restriction**

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-4, 16, and 22-23 drawn to a method of capturing and providing demographic information concerning a consumer of products to a manufacturer of such products during transactions in which the consumer utilizes a bar code reader and the Internet for product inquiries, classified in class 705, subclass 10.
  - II. Claim 24, drawn to a computer-implemented method that facilitates retrieval of information, classified in class 707, subclass 3.  
  
Claim 25, drawn to a computer-implemented method that providing information, classified in class 707, subclass 3.
4. The inventions are distinct, each from the other because of the following reasons  
  
Inventions I, and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as formulating and receiving a web-based search query system. See MPEP § 806.05(d).

Art Unit: 3623

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Newly submitted claims 24 and 25 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 24 and 25 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### **Claim Rejections - 35 USC § 103**

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

Art Unit: 3623

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-3 and 16-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hudetz et al (U.S. Patent No. 5,978,773) in view of Barnett et al (U.S. Patent No. 6,336,099) as set forth in the last Office Action mailed on June 6, 2005.

9. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hudetz et al and Dialog as applied to claim 1 above, and further in view of Kaplan (U.S. Patent No. 5,963,916) as set forth in the last Office Action mailed on June 6, 2005.

#### **REMARKS**

10. With respect to applicants' comment to the typographical error on page 4 of paragraph 2 of the last office action, the examiner thanks applicants for noting that error. The examiner inadvertently typed Dialog instead of Barnett et al.

Applicants asserted that the combination of Hudetz with Barnett et al teach applicant's claimed invention. Applicants supported their assertion by arguing that the combination of Barnett et al with Hudetz et al does not supply demographic information to suppliers as a result of an information request. The examiner respectfully disagrees with applicants, arguments because Barnett et al teaches providing the demographic information based on requested coupon data. Note col. 5, lines 3-8; col. 7 line 56 through col. 8, line 5.

In response to applicant's argument that the Office Action's cannot use hindsight reconstruction to pick up and choose isolated disclosures in the prior art to depreciated the claimed invention, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account

Art Unit: 3623

only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Accordingly, the rejection is maintained.

Response to the arguments of claims 24 and 25 is deemed not necessary because of the Election/Restriction noted above.

Further, applicants asserted that Kaplan does not make up for the aforementioned deficiencies of Hudetz et al. and Barnett et al. Applicant further supported their assertion by arguing that the examiner is basing the rejection on the assertion that it would have been obvious to do something not suggested in the prior art. In response, the examiner respectfully disagrees with applicants' argument because Kaplan does teach the concept of collecting demographic information of a user and doing marketing research with the user's demographic information. It would have been obvious to a person of ordinary skill in the marketing art to combine the teachings of Hudetz et al and Barnett et al in order to allow for the periodic delivery of market research.

### **Conclusion**

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

Art Unit: 3623

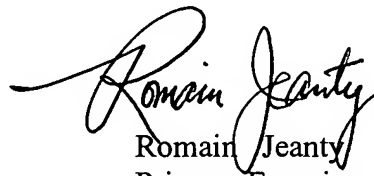
the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Romain Jeanty whose telephone number is (571) 272-6732. The examiner can normally be reached on Mon-Thurs 7:30 AM - 6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq R. Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

November 23, 2005

  
Romain Jeanty  
Primary Examiner  
Art Unit 3623